

### REMARKS

In the Action mailed December, 27, 2007, the Examiner rejected all pending claims 1-15. In reply, Applicant has amended independent claims 1, 6, and 11 as well as dependent claims 3, 8, and 13. As such, claims 1-15 are pending. Applicant request favorable consideration of the claims in view of the amendments and the following remarks.

Independent claim 1 is amended to recite the steps of "creating and storing in a repository a rule that during execution..." and "binding the rule in the repository to the specified user-selectable option..." These amendments are supported by the present disclosure. For example, claim 1 is supported by page 17, lines 11-17, where it is described that "For example, using the editor, a user may specify a validation rule requiring that, "if field-1 has value 'A', the field-2 value must be greater than 100. Once a validation rule is specified, the rule editor stores the validation rule in a validation rule base 72 that is accessed during execution of the software configuration program 44." In another example, as described on page 18, lines 5-8, "If allowable values have been previously defined, the validation rule is generated 70 using these previously defined values and is stored in validation rule base 72." Claim 1 is further supported by page 22, lines 3-8, "As a result, the refinement area 88 provides the ability to bind instructions that are to be executed upon a user selection of a 'user-selectable option'. Once these rules are bound, user selection of the 'user-selectable option' during execution of the software configuration program 44 triggers execution of the rule."

Independent claims 6 and 11 are amended along the same lines as independent claim 1 and these amendments are also supported as noted above.

Dependent claim 3, 8, and 13 are amended to be consistent with the amended claims 1, 6, and 11, respectively.

No new matter is added.

### **Claim Rejections - 35 U.S.C. § 112**

The Examiner rejected claims 11-15 under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter. Particularly, the Examiner took the position that the Applicant seems to be claiming both the product and the process.

This rejection is respectfully traversed. The test for definiteness is whether one skilled in the art would understand the bounds of the claim when read in light of the specification. *Miles Labs., Inc. v. Shandon Inc.*, 997 F.2d 870, 875 (Fed. Cir. 1993), *cert. denied*, 510 U.S. 1100 (1994). Moreover, there is nothing inherently wrong with defining some part of an invention in functional terms. *See, e.g.*, MPEP 2173.05(g).

The Examiner has not pointed to any indefinite language in independent claim 11. Applicant submits that there are no vague or ambiguous terms or expressions used in the claim. Rather, claim 11 defines an article which stores instructions in terms of the operations that the instructions cause a machine to perform. It is well established that computer programs embodied in a tangible medium, such as floppy diskettes, are patentable subject matter under 35 U.S.C. § 101 and must be substantively examined. *In re Beauregard*, 53 F.3d 1583, 1583 (Fed. Cir. 1995). Applicant's claim 11 satisfies the standard for computer program product claims under *Beauregard* and its progeny. Moreover, the Examiner has not pointed to any reason why an ordinary artisan would not understand the bounds of claim 11 as written.

Applicant respectfully requests that the rejection be withdrawn.

### **Claim Rejections - 35 U.S.C. § 101**

The Examiner rejected claims 1-5 and 11-15 under 35 U.S.C. § 101 as directed to non-statutory subject matter. Claims 1 and 11 are independent claims, claims 2-5 depend from claim 1, and claims 12-15 depend from claim 11. The Examiner took the position that claims 1-5 were directed to a process, not directed to machine, manufacture, production of a physical transformation, or a composition of matter and that creating a rule, binding and executing do not necessarily produce a tangible result. The Examiner also took the position that claims 11-15 fail

to fall within a statutory category of invention as they were directed to a program itself, not a process occurring as a result of executing the program.

Without conceding that the rejection has merit, Applicant has amended claim 1 to recite “creating and storing in a repository a rule that during execution of the configuration program determines which of the user-selectable options for a step are displayed when a specified user-selectable option of a previous step is selected, and binding the rule in the repository to the specified user-selectable option so that during execution of the configuration program the rule is executed when the specified user-selectable option is selected. The above amendment to claim 1 includes storing the created rule in a repository. Further, the rule is bound to a specified user-selectable option until execution of a configuration program executes the rule. Thus, after the rule creation, storing, and binding are performed, the bound rule and user-selectable option(s) (e.g., results) are stored in the repository for later use.

The above method is tangible because the rule is available and selectable for execution by the user. For example, the rule is stored in a repository for future access or execution.

Applicant amended claim 11, dependent claim 3, and dependent claim 13 along the same lines as the independent claim 1 and these amendments are also supported as noted above. Applicant asks that the Examiner remove the rejection of claims 1-5 and 11-15 on this basis.

### **Claim Rejections - 35 U.S.C. § 102 and 103**

The Examiner rejected pending claims 1-3, 5-8, 10-13, and 15 under 35 U.S.C. § 102(b) as being anticipated by SAP Wizard Builder (a reference provided by the Applicant in an Information Disclosure Statement and referred to as “Screen Shots of a Wizard Builder sold by SAP AG, 7 sheets). The Examiner also rejected remaining pending claims 4, 9, and 14 under 35 U.S.C. § 103(a) as being unpatentable over SAP Wizard Builder in view of Watson-Luke et al. (USPA 2005/0114240). Claims 1, 6, and 11 are independent. Without conceding that the rejections have merit, Applicant submits that claims 1-15, as amended, are patentable over the prior art of record.

Applicant's claim 1 is directed to a method to be executed as part of a process for creating an executable configuration program that comprises multiple steps that are successively executed and wherein associated with each of the steps are user-selectable options, the method comprising creating and storing in a repository a rule that during execution of the configuration program determines which of the user-selectable options for a step are displayed when a specified user-selectable option of a previous step is selected, and binding the rule in the repository to the specified user-selectable option so that during execution of the configuration program the rule is executed when the specified user-selectable option is selected. Applicant submits that SAP Wizard Builder does not anticipate a method that is dependent upon user created rules for displaying user-selectable options.

Screen shots 1-7 of the SAP Wizard Builder appear to generally illustrate steps that are performed when building a wizard. In particular, screen shot 4 of the SAP Wizard Builder reference shows a new wizard beginning at a "start" screen. The start screen indicates that it enables a user to manage all system wizards, create new wizards, and execute existing wizards. In the depicted example, the screen indicates that the SAP Wizard Builder "should be executed only if you know the structure of the wizard to be created" and continues with "You should first consider how many screens are required and the distribution of the input fields." Applicant submits that the SAP Wizard Builder screen shot 4 does not imply or show that rule creation or binding of said rule to a user-selectable option is available. In fact, the SAP Wizard Builder screen shot 4 indicates that users must know a predetermined order of screens before creating the wizard. Thus, a screen may not be created out of order and may not have "rules" applied to the screens after creation.

As shown in screen shot 5 of SAP Wizard Builder, the screen can be used to name and title a new wizard before creating the wizard. The entered information can be used by the SAP Wizard Builder to create a function group. The SAP Wizard Builder reference states "Screens, callback FORM routines, etc. are created in the function group." Applicant submits that the SAP Wizard Builder screen shot indicates that screens and callback FORM routines can be created

with the wizard, but does not indicate that rules and rules bound to user-selectable options can be created for the screens.

As shown in screen shot 6 of SAP Wizard Builder, a user can determine wizard steps and specify screen text. Specifically, the screen shot 6 shows that “You can specify the following data per step: A step description that can be understood by users in the roadmap...” and a description via the input area. Applicant submits that SAP Wizard Builder does not include the ability to create rules based on user-selectable options by determining wizard steps and screen text.

As indicated in screen shot 7 of SAP Wizard Builder, it appears that a user can refine steps determined in screen shot 6. For example, the user is shown that “A subscreen must be assigned to each wizard step except for the start and end screens, in which the user can input data.” Here, the order of the screens and subscreens is apparently determined according to the order in which the user creates the screens. Moreover, SAP Wizard Builder does not indicate whether the user can modify an existing screen or subscreen, but apparently allows the user to accept or view predefined subscreens. The SAP Wizard Builder reference recommends “you accept the proposed values...you enter a subscreen that has already been defined” without giving the user an option to set up rules related to user-selectable items.

The SAP Wizard Builder reference does not disclose or suggest a method that is dependent upon user created rules for displaying user-selectable options. As such, it cannot be said that Applicant's independent claim 1 is anticipated by the SAP Wizard Builder reference. Independent claim 1 is therefore patentable over the reference

The Examiner cited Watson-Luke et al. teaches that creating the textual explanation comprises translating the textual explanation into at least one different language. However, no reference is made to a method which is dependent upon user created rules for displaying user-selectable options before translating the “textual explanation” of the user-selectable options. As such, it cannot be said that Applicant's claims 4, 9, and 14 are rendered obvious by this reference.

Accordingly, Applicant requests that the Examiner remove the anticipation rejection of claims 1-3, 5-8, 10, 12, 13, and 15, as well as the obviousness rejection of claims 4, 9, and 14.

With respect to independent claim 11, claim 11 is directed to a computer program product that contains instructions for executing a method. Particularly, independent claim 11 recites language regarding the creation, storage, and binding of rules in a repository. For the reasons similar to those described previously in connection with claim 1, claim 11 is also patentable. As such, Applicant requests the Examiner to remove the anticipation rejection of this claim as well.

## **Conclusion**

Applicant requests favorable consideration of claims 1-15 as amended.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

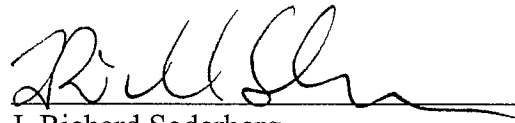
Please apply the fee of \$120 for the extension of time and any other charges or credits to deposit account 06-1050.

Applicant : Yuh-Cherng Wu  
Serial No. : 10/829,145  
Filed : April 21, 2004  
Page : 12 of 12

Attorney's Docket No.: 13906-122001 / 2003P00271  
US

Respectfully submitted,

Date: 4/23/08

  
\_\_\_\_\_  
J. Richard Soderberg  
Reg. No. 43,352

Fish & Richardson P.C.  
60 South Sixth Street  
Suite 3300  
Minneapolis, MN 55402  
Telephone: (612) 335-5070  
Facsimile: (612) 288-9696